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10/083,017	02/26/2002	Douglas Alan Miller	45568-00425	4317

7590 05/22/2003  
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EXAMINER

JACOBSON, TONY M

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 05/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/083,017

Applicant(s)

MILLER ET AL.

Examiner

Tony M. Jacobson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 28 recites the limitation "the second performance parameter" in lines 1-2 (of the claim). There is insufficient antecedent basis for this limitation in the claim. Neither claim 22 nor 23 makes any prior mention of a second performance parameter.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 13, 20, 22-25, 30-32, and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Leysieffer (USPN 6,554,762).

7. Regarding claims 1, 20, 22, 30, and 34, Leysieffer discloses in Fig. 1, an implantable hearing aid (12) with means for measuring its coupling quality, which comprise a test device (programming system 22 in cooperation with telemetry system 20, microcontroller 17, DSP 13, and driver and impedance measuring system 28) configured to provide at least one predetermined test signal for use in generating an electrical signal passing through the actuator (column 8, lines 52-57) to obtain at least one test measure (the impedance) of an electrical signal passing through an implanted hearing aid actuator (16) to assess at least one performance parameter of the hearing aid; and a positioning system (column 4, lines 14-18) connected to the actuator to selectively position the actuator relative to a component of the auditory system based on the assessed at least one performance parameter (column 6, lines 53-61). The inherent normal method of testing the quality of the coupling of the actuator to a

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component of a patient's auditory system according to the system of Leysieffer would comprise positioning a test measurement device (element 22 of Fig. 1) external to a patient having the implanted actuator; utilizing the test measurement device to obtain at least one test measure of an electrical signal passing through the actuator (column 14, lines 44-48 and claim 13) ; and employing the at least one test measure to assess at least one performance parameter for the hearing aid (claim 1).

8. Regarding claims 2, 3, 23, and 24, Leysieffer discloses at column 6, lines 46-63 that means are provided for objectively determining the quality of coupling between the output transducer (actuator) and the coupled auditory element based on a test measure (the measured impedance). Objective determination based on measured quantities inherently comprises comparing the measured quantities to one or more predetermined ranges. Leysieffer discloses at column 13, line 66 through column 14, line 7 that the microcontroller (17) of the implanted hearing aid communicates bi-directionally through the closed skin with an external programming system (22), which can advantageously be a PC-based system with the corresponding programming, processing, display, and administration software. Although Leysieffer does not explicitly disclose the detailed nature of the output provided to the operator of the system, one of ordinary skill in the art would conclude that means are included within the programming system to provide a user-interface output, via a display of the PC-based programming system, indicative of one or more performance parameters.

9. Regarding claim 9, Leysieffer discloses at column 8, lines 23-31, means for detecting (and thus identifying) the spectral distribution of resonance frequencies of the

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transducer in the course of the impedance measured as a function of the frequency of the stimulation signal.

10. Regarding claims 13 and 25, as described above regarding claims 2, 3, 23, and 24, Leysieffer discloses that means are provided for objectively determining the quality of coupling between the output transducer (actuator) and the coupled auditory element based on the measured impedance. Objective determination based on measured quantities inherently comprises comparing the measured quantities to a one or more predetermined ranges using appropriate means, and testing the quality of the actuator coupling to an auditory element as disclosed by Leysieffer will inherently indicate if the hearing aid is operational and thus will implicitly perform the step claimed.

11. Regarding claim 31, Leysieffer discloses at column 8, lines 1-17 that impedance measurements (and thus voltage and current measurements) are made at frequencies extending over the entire transmission frequency range of the output transducer (actuator), which inherently requires providing a plurality of predetermined test signals having different frequencies distributed across a predetermined frequency range for use in generating a corresponding plurality of electrical signals passing through the actuator.

12. Regarding claim 34, as broadly as claimed, any test signal has a frequency that is within some (predetermined) range of a resonant frequency of an actuator.

Additionally, Leysieffer discloses at column 8, lines 23-29 that impedance is measured at resonance frequencies, which inherently requires the signal generator to output test signals at those resonant frequencies.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4-12, 14, 15, 21, 26-28, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leysieffer (USPN 6,554,762) in view of Leysieffer (USPN 6,077,215).

15. Regarding claims 4 and 26, it would have been obvious to one of ordinary skill in the art at the time the present invention was made to compare the measured impedance value obtained by the system of Leysieffer with any desired number of predetermined ranges which are at least partially non-overlapping, utilizing appropriate means, in order to categorize the test results. Further, it would have been obvious to make a plurality of ranges at least partially non-overlapping since, if the ranges were not at least partially non-overlapping, they would be identical and the results of the comparisons would duplicate each other.

16. Regarding claims 5 and 27, one of ordinary skill in the art would conclude that means are included and utilized in the system of Leysieffer to provide an output indicative of one or more performance parameters, otherwise the results of the measurements would be useless and the device would be non-functional with respect to the desired test function.

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17. Regarding claim 6, Leysieffer discloses at column 8, lines 52-57 that the signal processor (13) generates measuring signals, which inherently would be “predetermined”.

18. Regarding claims 7 and 8, Leysieffer discloses at column 8, lines 1-17 that impedance measurements (and thus voltage and current measurements) are made at frequencies extending over the entire transmission frequency range of the output transducer (actuator), which inherently requires providing a plurality of predetermined test signals having different frequencies distributed across a predetermined frequency range for use in generating a corresponding plurality of electrical signals passing through the actuator.

19. Regarding claims 10, 14, and 28, as broadly as claimed, any test signal has a frequency that is within some (predetermined) range of a resonant frequency of an actuator. Additionally, Leysieffer discloses at column 8, lines 23-29 that impedance is measured at resonance frequencies, which inherently requires providing test signals at those resonant frequencies. As described above regarding claims 2, 3, 23, and 24 under the heading “Claim Rejections 35 USC 102”, Leysieffer discloses that means are provided for objectively determining the quality of coupling between the output transducer (actuator) and the coupled auditory element based on the measured impedance. Objective determination based on measured quantities inherently comprises comparing the measured quantities to a one or more predetermined ranges.

20. Regarding claim 11, Leysieffer discloses in Fig. 11 and describes at column 20, line 64 through column 21, line 13, a partially-implanted hearing aid in which the signal



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processor is disposed in an external unit, and in which the test signals are inherently transmitted transcutaneously between the external unit and the implanted actuator. Although Leysieffer does not explicitly state that the test signals are transmitted between an external transmitter and a subcutaneous coil, Leysieffer does explicitly disclose at column 13, line 66 through column 14, line 3 that the transcutaneous communication of signals between the implanted unit 12 and external system 22 in the fully implanted hearing aid system of Fig. 1 is performed wirelessly by way of an inductive coupling coil. It would have been obvious to one of ordinary skill in the art at the time the present invention was made to utilize the same transmission method in the embodiment of Fig. 11, so that the test signals are inductively coupled between an external transmitter and a subcutaneous, wherein the subcutaneous coil provides the electrical signal to the actuator.

21. Regarding claims 12 and 36, Official notice is taken that it is notoriously well known in the art to include in an implanted hearing aid an implanted microphone for reception of the external acoustical signals which are to be processed by the hearing aid for presentation to the user of the hearing aid (as disclosed by Leysieffer), and that further, it is well known to supply acoustic test signals to the implanted hearing aid through the implanted microphone in order to test the operation of the hearing aid. It would have been obvious to one of ordinary skill in the art at the time the present invention was made to apply this well-known method to the system of Leysieffer and supply the test signals to the implanted actuator(16) of Fig. 1 through one or more of the implanted microphones (10a-10n).

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22. Regarding claim 15, Leysieffer discloses at column 6, lines 54-62 that if the coupling quality of the output transducer (actuator) is judged inadequate, it can be improved. One of ordinary skill in the art would conclude that such improvement would be achieved by repositioning the actuator to achieve a desirable interface.

23. Regarding claim 21, Leysieffer discloses at column 7, lines 41-44 that an impedance measure is computed from the voltage and current measurements. While Leysieffer does not disclose that the measured voltage and current are provided to the (external) test measurement device or that the corresponding impedance is calculated in the (external) test device, the option of transmitting the actuator voltage and current measures to an external test device for subsequent calculation of an impedance therein, as opposed to calculating the actuator impedance within the implanted hearing aid and transmitting the resulting calculated impedance measure to the external test device is an obvious design choice, which does not produce any new or unexpected result. It would have been obvious to one of ordinary skill in the art at the time the present invention was made to calculate the actuator impedance either within the hearing aid or within the external test device as convenient.

24. Regarding claim 35, Leysieffer discloses in Fig. 11 and describes at column 20, line 64 through column 21, line 13, a partially-implanted hearing aid in which the signal processor is disposed in an external unit, and in which the test signals are inherently transmitted transcutaneously between the external unit and the implanted actuator. Although Leysieffer does not explicitly state that the test signals are transmitted between an external transmitter and a subcutaneous coil, Leysieffer does explicitly

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disclose at column 13, line 66 through column 14, line 3 that the transcutaneous communication of signals between the implanted unit 12 and external system 22 in the fully implanted hearing aid system of Fig. 1 is performed wirelessly by way of an inductive coupling coil. It would have been obvious to one of ordinary skill in the art at the time the present invention was made to utilize the same transmission method in the embodiment of Fig. 11.

25. Claims 19 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leysieffer (USPN 6,554,762) in view of Durand (USPN 6,154,023).

1. Regarding claims 19 and 33, as described above regarding claims 1, 20, 22, 30, and 34 under the heading "Claim Rejections 35 USC 102", Leysieffer discloses in Fig. 1, an implantable hearing aid (12) with means for measuring its coupling quality, which meets the limitations of claims 1 and 22. Leysieffer does not disclose that the at least one test measure comprises a measure of a magnetic field generated by the implanted hearing aid actuator in response to the electrical signal passing through the actuator; rather, the system of Leysieffer determines the current through the actuator more directly by measuring a voltage drop across a current sampling resistor ("R<sub>m</sub>" in Fig. 2). In Fig. 11, Leysieffer discloses an embodiment of the invention in which the hearing aid is a partially-implanted type, including the elements of Fig. 1 (sans telemetry system 20), in which a passive electronics module (74) is implanted along with a transducer (16 or 36), and in which the remainder of the electronics are disposed in an external unit (76). The specific details of this embodiment are described at column 20, line 64 through column 21, line 13, where Leysieffer discloses that the impedance measuring

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system (25) of Fig. 1 is included in the implanted portion of the hearing aid. Durand discloses in Fig. 1, a system for remotely measuring a current in an implanted medical device using a pair of sensors to measure a generated magnetic field. Since one of ordinary skill in the art would recognize that the voltage applied to the actuator (16 or 36) could be estimated in the external unit (76) based on the level at which a signal is transmitted to the implanted passive electronics module (77) by the external unit, it would have been obvious to one of ordinary skill in the art at the time the present invention was made to substitute the remote current sensing system of Durand, located in the external unit (76), for the implanted impedance measuring system of Leysieffer to create a test system that does not require the passive electronics module (77) to transmit measurement data back to external unit (76), thus simplifying the structure of implanted passive electronics module (77) and reducing its power requirements.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-8, 19, 21-34, and 36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-21 of copending Application No. 10/083,181. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the instant application is anticipated by claim 16 of the copending application and claims 2-5 are obvious variations thereof; claims 6-8 are obvious variations of claims 17-19, respectively, of the copending application by the same reasoning; claims 19 and 21 are anticipated by claims 20 and 21 of the copending application; claim 22 is anticipated by claim 16 of the copending application and claims 23-25, 29 are obvious variations thereof; claim 29 is an obvious variation of claim 19 in the copending application; claim 30 is anticipated by claim 17 of the copending application; claims 31-34 are obvious variations of claims 18, 21, 20, and 17, respectively, of the copending application; and claim 36 is an obvious variation of claim 17 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-19, 22-28, 30, 31, and 33-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, 17-26, 28, and 30 of copending Application No. 10/082,989. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6 are anticipated by claims 1-6, respectively of the copending application; claims 7-9 are obvious combination of claim 4 in combination with claims 17-19, respectively, of the copending application; claims 10-19 are anticipated by claims 7-15 and 1, respectively, of the copending application; claims 22-28 are obvious variations of claims 20-22, 28, 23, 24, and 30, respectively, of the copending application; claims 30 and 31 are obvious variations of claims 6 and 26, respectively of the copending application; claims 33 and 34 are obvious variations of claims 20, 25, respectively, of the copending application; and claims 35 and 36 are obvious variation of claims 6 and 20 in combination with claims 8 and 9, respectively, of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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5. Claims 1-18, 20-28, 30-32, and 34-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15, 17-27, 29, and 30 of copending Application No. 10/083,024. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6 are anticipated by claims 1-6, respectively, of the copending application; claims 7-9 are obvious combinations of claim 4 in combination with claims 18-20, respectively, of the copending application; claims 10-18 are anticipated by claims 7-15, respectively, of the copending application; claims 20 and 21 are anticipated by claims 1 and 17, respectively, of the copending application; claims 22-28 are obvious variations of claim 13 in combination with claims 21-23, 29, 24, 25, and 30, respectively, of the copending application; claims 30-32 and 34 are anticipated by claims 21, 27, 21, and 26, respectively, of the copending application; and claims 35 and 36 are obvious variations of the combination of claim 21 in combination with claims 8 and 9, respectively, of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

26. Claims 16-18, and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (and subject to overcoming the provisional double patenting rejections stated above).

27. The following is a statement of reasons for the indication of allowable subject matter: A method or system for assessing and adjusting the coupling performance of an implanted-actuator hearing aid, comprising measuring the impedance of the actuator in response to a signal passing through the actuator, in combination with an electrically-operated actuator positioning device is not taught or fairly suggested in the prior art.

***Conclusion***

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

29. Lehner et al. (USPN 5,788,711) discloses the preferred implanted actuator positioning system referred to at column 4, lines 14-18 of Leysieffer (USPN 6,554,762).

30. Engebretson et al. (USPN 5,085,628) disclose an implantable hearing aid coupler device with the teaching of matching the mechanical output impedance of the actuator to the mechanical input impedance of the coupled auditory element.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tony M. Jacobson whose telephone number is (703) 305-5532. The examiner can normally be reached on Mon. -Fri. 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9315 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

tmj  
May 19, 2003

  
FORESTER W. ISEN  
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